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10/590,120	08/18/2006	Detlef Hutt	05581-00147-US	2101
23416	7590	06/08/2009	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP			FERGUSON, LAWRENCE D	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,120	<b>Applicant(s)</b> HUTT, DETLEF
	<b>Examiner</b> Lawrence D. Ferguson	<b>Art Unit</b> 1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 March 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12, 14-22 and 24-33 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12, 14-22 and 24-33 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

***DETAILED ACTION***

***Response to Amendment***

1. This action is in response to the amendment mailed March 2, 2009.

Claims 1-12, 14-22 and 24-33 were amended, claim 13 was cancelled rendering claims 1, 3-10, 12-13, 15-19 and 38-40 pending.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections – 35 USC § 103(a)***

3. Claims 1-3, 6-12, 14, 18-22, 24-27 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroki et al (U.S. 6,544,607).

Kuroki discloses a multiple layer biaxially oriented film comprising a base layer (column 7, lines 31-37 and column 8, lines 53-66) where an antistatic layer, for example, is formed on both surfaces of the film (column 8, lines 57-66) which renders the bottom antistatic layer as the base layer. At least one covering layer of the base layer is a polyester composition comprising aliphatic hydroxycarboxylic acid, glycerin fatty esters and mica (column 2, lines 7-12, 50-54 and column 6, lines 15-25, 44-45) where the glycerin fatty ester can be glycerin monostearate (column 6, lines 44-45)

which Applicant defines as a glycerin monofatty acid ester on page 5, second paragraph of the instant specification. The glycerin component is 1 to 10 parts by weight of the aliphatic polyester (column 2, lines 47-49). The aliphatic polyester film (covering layer) has a thickness of from 5 to 1000 $\mu$ m (column 2, lines 50-64). In claim 1, the phrase, "coextruded film" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims.

Although Kuroki does not explicitly disclose the weight percentage of mica, the reference teaches anti-blocking agents, such as mica, can be added in the range wherein the invention can be accomplished (column 6, lines 15-23). Because the reference teaches the weight percentage of the mica can be varied, the weight percentage of the mica is optimizable. It would have been obvious to one of ordinary skill in the art to optimize the mica component of the covering layer because discovering the optimum or workable range involves only routine skill in the art. The weight percentage of mica directly affects gloss of the film. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. Additionally, it would have been obvious to one of ordinary skill in the art to add mica in a weight percentage between greater than 0 to 0.5 or 2% so the mica would not have a negative impact on the surface gloss of the film by increasing the opacity of the surface. Recitation of a newly disclosed property does not

distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773, as in claims 1-3, 6, 18 and 26. Regarding claim 26, the phrase up to 0.3% by weight of wollastonite is interpreted as including 0.0% of wollastonite.

Concerning claims 7-8, the covering layer additionally contains kaolin (column 6, lines 15-23 and 54-64). Although Kuroki does not explicitly disclose the weight percentage of kaolin, the reference teaches a filler, such as kaolin, can be added in the range wherein the invention can be accomplished (column 6, lines 15-23). Because the reference teaches the weight percentage of the kaolin can be varied, the weight percentage of the kaolin is optimizable. It would have been obvious to one of ordinary skill in the art to optimize the kaolin component of the covering layer because discovering the optimum or workable range involves only routine skill in the art. The weight percentage of kaolin directly affects gloss and opacity of the film. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. Additionally, it would have been obvious to one of ordinary skill in the art to add kaolin in a weight percentage between greater than 0.5 and 0.3% so the kaolin would not increase the opacity of the surface, as in claim 8. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773.

Concerning claim 9, the polymer of aliphatic hydroxycarboxylic acid is 80 parts by weight of the covering layer (column 7, lines 57-63).

Concerning claims 10 and 27, the aliphatic hydroxycarboxylic acid is polylactic acid (column 2, lines (column 2, lines 50-59), which is PLA.

Concerning claim 11, Kuroki discloses the film has excellent transparency and comprises 90 percent by weight of polyhydroxycarboxylic acid (column 2, lines 15-22, 46-54) where the film is cut and/or formed into a bag, which is sealed (column 8, lines 4-12).

Concerning claims 12, 19-22 and 30-31, layers having filler material such as kaolin, titanium oxide or calcium carbonate can be applied to either surface of the film (column 6, lines 15-22, 54-64 and column 8, lines 57-67) where the filler material increases the opacity of the applied layer and is vacuole initiating, as defined on page 11 of the instant specification. Because Kuroki discloses a base with equivalent materials as in instant claim 18, it would have been obvious to one of ordinary skill in the art to include the optimum value of the vacuole initiating filler. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Additionally, it would have been expected to one of ordinary skill in the art for the quantity of titanium oxide to have a weight percentage of 3 to 15% to maintain a proper opacity without adding too much coloration to the packaging film, which could penetrate to the product of the film.

Concerning claim 14, Kuroki discloses the covering layer is sealable (column 8, lines 4-12). In claim 14, the term "sealable" constitutes a 'capable of' limitation and that

such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Concerning claims 24-25 and 33, the reference discloses glycerine monostearate and antiblocking particles are incorporated in the covering layer along with lactic acid polymers and polyethylene, which is a polyolefin (column 2, lines 50-59, column 6, lines 15-32, 44-53) where the lactic acid and/or polyethylene are interpreted as being a concentrate, based upon the instant specification's disclosure of a concentrate being based on lactic acid polymers or polyolefins, such as polyethylene (1<sup>st</sup> paragraph, page 14).

Concerning claim 32 Kuroki discloses a packaged product comprising a film having a multiple layer biaxially oriented film comprising a base layer (column 1, lines 7-16, column 2, lines 26-34, column 7, lines 31-37 and column 8, lines 53-66) where an antistatic layer, for example, is formed on a surface of the film (covering layer) (column 8, lines 57-66). The covering layer is a polyester composition comprising aliphatic hydroxycarboxylic acid, glycerin fatty esters and mica (column 2, lines 7-12, 50-54 and column 6, lines 15-25, 44-45). The glycerin component is 1 to 10 parts by weight of the aliphatic polyester (column 2, lines 47-49).

***Claim Rejections – 35 USC § 103(a)***

4. Claims 4-5, 15-17 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroki et al (U.S. 6,544,607) in view of Bissot (U.S. 4,818,782).

Kuroki is relied upon for claim 1, as above. Although Kuroki discloses a package film comprising aliphatic hydroxycarboxylic acid, a glycerine fatty ester and mica, the reference does not explicitly disclose the particle size or aspect ratio of mica. Because Kuroki does not specifically teach the particle size or aspect ratio of mica, one of ordinary skill in the art would look to the prior art, such as Bissot, to teach a specific mica for use within the disclosed film. Bissot teaches a multilayer package (column 1, lines 10-15) comprising mica having a particle size smaller than 38 microns and having an aspect ratio of 10 to 150 (column 4, lines 4-5, 20-36). Kuroki and Bissot are combinable because they are related to a similar technical field, which is packaging films. Therefore, it would have been obvious to one of ordinary skill in the art to have substituted the mica of Bissot for the mica of Kuroki to achieve the predictable result of improving the barrier properties of the packaging film (column 1, liens 57-59 and column 2, lines 33-36), as in claims 4-5.

Concerning claim 15-17 and 28-29, Kuroki does not disclose the gloss, surface resistance or dynamic coefficient of friction. Because Kuroki discloses a film with equivalent materials as in instant claim 1, it would have been obvious to one of ordinary skill in the art to include the optimum values of the gloss, surface resistance and dynamic coefficient of friction. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773.

***Response to Arguments***

5. The rejection made under 35 U.S.C. 112, second paragraph, is withdrawn due to Applicant amending claims 6 and 28 and clarifying claim 31 to more particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's arguments of the rejection made under 35 U.S.C. 103(a) as being unpatentable over Kuroki et al (U.S. 6,544,607) have been considered but are unpersuasive. Applicant argues the aliphatic polyester film of Kuroki is the base layer, rendering the covering layers as not comprising the components required by the covering layers recited in the present claims. Kuroki discloses a multiple layer biaxially oriented film comprising a base layer (column 7, lines 31-37 and column 8, lines 53-66) where an antistatic layer is formed on both surfaces of the film (column 8, lines 57-66) which renders the bottom antistatic layer as the base layer. The covering layer is a polyester composition comprising aliphatic hydroxycarboxylic acid, glycerin fatty esters and mica (column 2, lines 7-12, 50-54 and column 6, lines 15-25, 44-45) where the glycerin fatty ester can be glycerin monostearate (column 6, lines 44-45). Applicant further argues the additional layers on the polyester film are not formed via coextrusion. Formed by coextrusion, introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims. Applicant argues Kuroki

does not disclose the thickness of the covering layers. The aliphatic polyester film (covering layer) has a thickness of from 5 to 1000 $\mu$ m (column 2, lines 50-64).

Applicant's arguments of the rejection made under 35 U.S.C. 103(a) as being unpatentable over Kuroki et al (U.S. 6,544,607) in view of Bissot (U.S. 4,818,782) have been considered but are unpersuasive. Applicant argues Bissot does not teach or suggest the features of claim 1 that Kuroki fails to teach. Because Kuroki has been maintained over instant claim 1 and Applicant has not specifically argued the rejection over claims 4, 5, 15-17, 28 and 29, Kuroki in view of Bissot is maintained for reasons of record.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample, can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/  
Patent Examiner, Art Unit 1794

/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1794